



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,348	07/30/2001	Shoji Suzuki	N9450.0023/P023	9150

24998 7590 01/25/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
2101 L Street, NW  
Washington, DC 20037

EXAMINER

SCHUBERT, KEVIN R

ART UNIT PAPER NUMBER

2137

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/916,348

Applicant(s)

SUZUKI ET AL.

Examiner

Kevin Schubert

Art Unit

2137

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07302001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 1-9 have been considered.

***Specification***

5           A substitute specification for the claims is required pursuant to 37 CFR 1.125(a) because the current Specification is replete with grammatical and reference errors. Examples of the errors within the Specification are listed below. Since correction of these errors would require amending a large number of paragraphs, a substitute specification is required.

10           A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets  
15 if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Examples of errors (not comprehensive) within the specification include the following:

Incomplete sentences (Page 1, lines 11-15; Page 2, lines 15-17);

20           Grammatical errors (Page 1, line 7; Page 1, line 18; Page 10, line 10; Page 10, line 11; Page 12, line 17; Page 13, line 16; Page 13, line 21; Page 13, line 22; Page 21, line 7; Page 21, line 8);

Spelling errors (Page 3, line 13);

Reference errors (Page 11, line 18; Page 11, line 19; Page 19, line 5);

Citation errors (Page 15, line 20 (there should be a space between the // and "home")).

25

***Claim Objections***

Art Unit: 2137

Claim 6 is objected to because of the following informalities: the word "transiting" is misspelled in part b). Appropriate correction is required.

Claim 7 is objected to because of the following informalities: "an communication line" is a  
5 grammatical error in part c). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless –  
  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15  
  
Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonnaure, U.S. Patent No. 5,862,339.

As per claims 1-5, the applicant describes a home server with the following limitations which are  
20 met by Bonnaure:

a) telephone number coincidence-checking means for determining whether or not it can be accepted to perform said requirement sent from the sending source (Col 5, lines 45-63);

b) modem means for receiving said requirement, which has been accepted by said telephone number coincidence-checking means (Col 8, lines 32-47; Fig 10; Fig 5);

25 c) protocol-processing means for converting a signal of said requirement to an internet service requirement (Col 8, lines 32-47);

d) internet service-offering means for offering said internet service corresponding to said internet service requirement to said sending source, which has been converted by said protocol-processing means (Col 8, lines 32-47);

Art Unit: 2137

e) control means for controlling equipment in said home if said internet service, which is to be offered by said internet service-offering means, needs a control process concerning said internet server (Col 8, lines 32-47; Col 4, lines 49-64);

5 The applicant should note that the home server is the WebTV server and the sending source is the set top box. In the Background of the Invention, the applicant lists the use of a set top box as a possible home server (Page 1). In Bonnaure's disclosed invention, the set top box is actually the sending source and the WebTV server is the home server. Also, according to the applicant in the Embodiments section, the home can be "any one of a detached house, a housing complex, a facility, or an apparatus installed in the open air, such as a vending machine" (Page 6). The WebTV server which is housed in a facility fits within the definition of a home environment and can be considered the home server.

Regarding part a), the applicant should note that the client's identity is verified before performing the requested service, and the requested service is not performed if the client's identity is not verified.

Regarding part b), Figure 10 illustrates the modem means, or network interface (1014), of the WebTV server which is used to transmit and receive messages across the data communication line (1020). The data communication line can be ISDN (Col 8, line 37), which would require modem means. The applicant should also note the use of an ISDN modem on the set top box (Fig 5) for the communication between the set top box and the WebTV server.

Regarding parts c), d), and e), the WebTV server, or home server, receives a requirement from the set top box, or sending source, via a communication line through the internet for an internet service connection (Fig 6). If authenticated, the WebTV server offers the internet service connection and controls equipment on the WebTV server for allowing the client access to its services over the internet (Col 4, lines 49-64). The protocol-processing means is done by the network interface (Fig 10) which converts the signal from the set top box requesting an internet connection to and services from the WebTV server.

25 As per claim 6, the applicant describes an internet service system with the home server according to claim 1, which is met by Bonnaure (see above), with the following limitations which are also met by Bonnaure:

Art Unit: 2137

- a) an information terminal for requiring an internet service (Fig 6);
- b) a communication line for transiting said internet service (Fig 6; Col 6, lines 30-39);
- c) a home server according to claim 1, for receiving said transmitted internet service (claim 1);
- d) wherein said internet service can be implemented by said information terminal (Fig 6);

5        Regarding part a), the information terminal is the WebTV client (610 of Fig 6), or set top box. The WebTV client requires an internet service between it and the WebTV server (620 of Fig 6).

      Regarding part d), the internet service is implemented by the information terminal (WebTV client), but no communication exists between the WebTV client and the WebTV server unless the WebTV server authenticates the WebTV client by checking his telephone number in the registry.

10

      As per claim 7, the applicant describes an internet service system with the home server according to claim 1, which is met by Bonnaure (see above), with the following limitations which are also met by Bonnaure:

- a) an internet for transmitting an internet service required from a sending source (Fig 6);
- 15        b) a service provider which receives said internet service from said internet, and implements said connection between said sending source and a receiving destination to which said sending source intends to connect (Fig 6);
- c) an communication line for transmitting said internet service (Col 6, lines 30-39);
- d) a home server according to claim 1, which receives said sent internet service (claim 1);
- 20        e) wherein said internet service can be implemented from said internet (Fig 6);

      Regarding part a), as described earlier, the WebTV server is the home server and the WebTV client is the sending source.

      Regarding part b), the conventional network (612 of Fig 6) comprises service providers which allow for the internet connection between the WebTV client and the WebTV server.

25        Regarding part e), as seen in Fig 6, the communication between the WebTV client and the WebTV server takes place over the internet.

Art Unit: 2137

As per claim 8, the applicant describes the home server of any one of claims 1-5, which are met by Bonnaure (see above), with the following additional limitation which is also met by Bonnaure:

Wherein said sending source comprises a calling-up person or a machine (Fig 6);

As described earlier, the sending source is the WebTV client, which is a machine.

5

As per claim 9, the applicant describes the home server of any one of claims 1-4, which are met by Bonnaure (see above), with the following additional limitation which is also met by Bonnaure:

Wherein said telephone number coincidence-checking means comprises a unit for confirming on a registration of a telephone number corresponding to a telephone accessing said home server (Col 5,

10 lines 45-63);

As described in the lines referenced above, the telephone number of a WebTV client in a house is checked. The WebTV client uses a telephone number, which corresponds to a telephone that could be used in the house, for connection purposes. The confirmation of the registration of the telephone number is described: "The WebTV server may use the requesting client's telephone number to authorize the completion of a requested service by comparing the requesting client's telephone number to a list of authorized telephone numbers maintained in the server" (Col 5, lines 51-55).

15

20

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

25

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
5 you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\*

10



**ANDREW CALDWELL**  
**SUPERVISORY PATENT EXAMINER**